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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,425	01/18/2002	Ernesto Fischer-Calderon	39,815	9062

4249 7590 07/29/2003

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EXAMINER

PARSA, JAFAR F

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 07/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/051,425

Applicant(s)
Fischer-Calderon et al

Examiner
J. Parsa

Art Unit
1621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 18, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 18, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3-4 6) ☐ Other:

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,564,578 in view of Rummelhoff (GB 2357140 A).

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Calderon teaches a process for producing LNG, comprising: (a) directing a feed stream comprising natural gas to a cooling stage, the cooling stage comprising the steps of: (I) cooling the feed stream in at least one cooling step producing a cooled feed stream; (ii) expanding the cooled feed stream in at least one expansion step by reducing the pressure of the cooled feed stream producing a refrigerated vapor component and a liquid component; and (iii) separating at least a portion of the refrigerated vapor component from the liquid component; and (b) repeating step (a) one or more times until at least a substantial portion of the feed stream in the first cooling stage is processed into LNG wherein the feed stream comprises at least a portion of the liquid component from step (iii) of a previous cooling stage; wherein at least a portion of the cooling for step (I) in at least one cooling stage is derived from at least a portion of the refrigerated vapor component produced in at least one cooling stage.

The difference between Calderon and the claimed invention is that Calderon does not teach converting at least a portion of natural gas vapor components to a GTL product. However, Rummelhoff in a similar process teaches converting a portion of natural gas vapor obtained from a liquefaction of natural gas to GTL product such as, methanol (see abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the vapor portion of the liquefied natural gas to a useful liquid product such as methanol as shown by Rummelhoff.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 32-37 are rejected under 35 U.S.C. 102(b) as being anticipate by Rummelhoff (GB 2357140 A) or Dunbar et al (WO 99/30094).

Claims 32-37 are product by-process claims. The product is a liquefied natural gas. Rummelhoff discloses a process for production of a liquefied natural gas (see abstract).

Dunbar also teaches a process for the production of a liquefied natural gas (see page 2).

PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE
MANIPULATIONS OF THE RECITED STEPS, ONLY THE STRUCTURE
IMPLIED BY THE STEPS

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Any inquiry concerning this communication from the examiner should be directed to J. Parsa, whose telephone number is (703)308-4615. The Examiner's normal work hours are Monday-Friday from 8:00 a.m. to 4:30 p.m. If Examiner is not in, please leave a message. Your call will be return as soon as possible. Any general inquiry of a general relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-1235. The Examiner's supervisor, Johann Richter, may be reached at (703)308-4532. Communications may now be transmitted via FAX directly to group 1600. The group 1600 FAX machine number is (703)308-4556.

J. PARSA
PRIMARY EXAMINER



July 23, 2003